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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/064,973	04/23/1998	MICHAEL F. VIDOLIN	044073-0281635	6821

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EXAMINER

MILLER, WILLIAM L

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/064,973

Applicant(s)

VIDOLIN ET AL.

Examiner

William L. Miller

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 27-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "42c" (page 9) and "44h" (page 11). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

2. The disclosure is objected to because of the following informalities: page 9 recites "clasps 42c" while page 11 recites "44c clasps". The clasps are referenced in Figs. 4 and 8 by reference numeral "44c". Appropriate correction is required.

### *Claim Objections*

3. Claim 35 is objected to because of the following informalities: line 2, change "seem" to --seam--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled *man* in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Moreover, Fig. 4 does appear to show the right-side closure element 44c having a cross-section that is larger than the loop opening of each closed loop member, however, the original claims, drawings, and/or specification fail to show or describe each closed loop member being elastically expanded to pass over the above said closure element so as to remove

each closed loop member from the friendship band. According to Fig. 4, it appears more probable each closed loop member would slidably pass over the smaller left-side closure element 44c, without elastic expansion, so as to remove each closed loop member from the friendship band.

5. Claims 27-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. It is unclear if the "plurality of closed loop members" recited in claim 27, line 7, are referencing the "closed loop members" previously recited in claim 27, line 1.
7. It is unclear if the "fabric material" recited in claim 35, line 2, is referencing the "second material" previously recited in claim 27, line 8. ✓
8. It is unclear if the "same material" recited in claim 36, line 2, is referencing the "first material" and the "second material" previously recited in claim 27, lines 3 and 8. Further, claim 36 is inconsistent with claim 27 as claim 36 indicates the band and closed loop members are made of the same material, while claim 27 indicates the band and closed loop members are made of two different materials, namely a first and second material. ✓
9. It is unclear if the "first friendship band" recited in claim 41, line 2, is referencing one of the "friendship bands" previously recited in claim 41, line 1.
10. In claim 41, line 3, there is no function recited for the "releasable closure means". ✓
11. It is unclear if the "second friendship band" recited in claim 41, line 9, is referencing one of the "friendship bands" previously recited in claim 41, line 1.

12. It is unclear if the "first friendship band" recited in claim 42, line 2, is referencing one of the "friendship bands" previously recited in claim 42, line 1.

13. In claim 42, lines 3 and 6, there is no function recited for the "releasable closure means".

14. It is unclear if the "second friendship band" recited in claim 42, line 5, is referencing one of the "friendship bands" previously recited in claim 42, line 1.

*Claim Rejections - 35 USC § 103*

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 27-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doppenschmitt (US#1694703) in view of Knodel (US#4179833).

17. Regarding claim 27, Doppenschmitt discloses a "friendship band" comprising: a band section 3 made of a first material that is flat in cross-section; and a plurality of closed loop members 1 each made of a second material that is flat in cross-section. Each closed loop member includes a loop opening that conforms to the cross-section of the band section, and indicia on a portion of an exposed surface thereof (page 1, line 110+). The closed loop members are strung via their openings onto the band section (page 1, lines 106-110). Since the closed loop members are strung onto the band section, the closed loop members are also removable from band section.

18. Although Doppenschmitt fails to specifically disclose the closed loop members being exchangeable with closed loop members of other friendship bands, the closed loop members of

other friendship bands are not being positively claimed and represents the intended use of the band. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the closed loop members are capable of being exchanged with closed loop members of other friendship bands.

19. Doppenschmitt fails to specifically disclose a closure means attached to the first and second ends of the band section as claimed by the applicant. Knodel discloses a similar band wherein band section 10 includes a closure means 12 attached to the first and second ends of the band section for releasably connecting the first end to the second end. The closure means facilitates wearing and removing the band as required. Therefore, as taught by Knodel, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the band of Doppenschmitt to include a closure means attached to the first and second ends of the band section for releasably connecting the first end to the second end thereby enhancing securement of the band to the person, i.e. improving the securement of the band to the person by providing a simpler means of wearing and removing the band.

20. Regarding claim 28, Doppenschmitt discloses the first material (band section) as an elastic material, namely spring steel.

21. Regarding claim 29, Doppenschmitt discloses the first material (band section) as an elastic material, namely spring steel, as opposed to elasticized plastic, rubber, plasticized rubber, or elasticized fabric as claimed by the applicant. However, it would have been an obvious to one of ordinary skill in the art at the time the invention was made to utilize elasticized plastic, rubber, plasticized rubber, or elasticized fabric material for the first material as the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).
22. Regarding claims 30 and 31, Doppenschmitt discloses the second material (closed loop member) as a material which may be ornamented as opposed to an elastic material, namely nylon or silk, as claimed by the applicant. However, it would have been an obvious to one of ordinary skill in the art at the time the invention was made to utilize an elastic material, namely nylon or silk, for the second material as the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).
23. Regarding claim 32, Doppenschmitt in view of Knodel discloses the closure means including a first portion attached to the first end of the band section and a second portion attached to the second end of the band section wherein at least one of the first and second closure means portions has a cross-section larger than the loop opening of each closed loop member. Since it is being viewed as an obvious design choice to utilize an elastic material for the closed loop member (claim 30), then the closed loop member is capable of being elastically expanded to pass over the at least one of the first and second closure means portions.

24. Regarding claims 33 and 34, Doppenschmitt discloses the closed loop members may be enameled or suitably colored or ornamented in any desired way to provide an article of the desired design and degree of ornamentality. Doppenschmitt fails to specifically disclose the indicia on each closed loop member as letters, numbers, insignias, emblems, corporate logos, stars, stripes, hearts, flowers, insects, animals, or being embroidered as claimed by the applicant. However, it would have been an obvious matter of design choice to modify the band of Doppenschmitt such that the indicia of the closed loop member included letters, numbers, insignias, emblems, corporate logos, stars, stripes, hearts, flowers, insects, animals, or was embroidered, since the applicant has not disclosed that the specific indicia design solves any stated problem or is for any particular purpose, and it appears the band would perform equally well with any suitable indicia on the closed loop members.
25. Regarding claim 35, Doppenschmitt discloses the second material (closed loop member) as a material which may be ornamented as opposed to a fabric joined at an inherent seam line as claimed by the applicant. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a fabric having an inherent seam line for the second material as the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Further, the applicant is reminded method limitations, such as stitching, gluing, stapling, and laser fusion, are given little patentable weight in an article claim as the patentability of a product does not depend on its method of production. See MPEP 2113.
26. Regarding claim 36, Doppenschmitt discloses the band section as an elastic spring steel material and the closed loop members as a material which may be ornamented as opposed to the



band section and closed loop members being made from the same material as claimed by the applicant. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the same material for the band section and the closed loop members as the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

27. Regarding claim 37, Doppenschmitt discloses the band section as being elongated as it can be worn as a necklace (page 2, line 20).

28. Regarding claim 38, Doppenschmitt discloses an outer surface layer 2.

29. Regarding claim 39, Doppenschmitt disclosed the outer surface layer as a wire fabric as opposed to cotton, rayon, nylon, silk, linen, or polyester as claimed by the applicant. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the band of Doppenschmitt by utilizing cotton, rayon, nylon, silk, linen, or polyester for the outer surface layer material as the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

30. Regarding claim 40, Doppenschmitt discloses the outer surface layer joined to the band section proximate the first and second ends thereof (page 1, lines 103-106). Further, the applicant is reminded method limitations, such as stitching, gluing, stapling, and laser fusion, are given little patentable weight in an article claim as the patentability of a product does not depend on its method of production. See MPEP 2113.

***Allowable Subject Matter***

31. Claims 41 and 42 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.
32. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 41, Doppenschmitt in view of Knodel disclose all the limitations of claim 41 except for exchanging a removed one of the closed loop members from the friendship band with a closed loop member removed from another friendship band. It would not have been obvious to one of ordinary skill in the art to modify the method disclosed by Doppenschmitt in view of Knodel to include exchanging a removed one of the closed loop members from the friendship band with a closed loop member removed from another friendship band.

Claim 42 includes the allowable subject matter indicated above with respect to claim 41 and is therefore allowable for at least the reasons set forth above.

***Response to Arguments***

33. Regarding claim 27, in response to applicant's argument that there is no suggestion or motivation to combine Doppenschmitt in view of Knodel, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is clearly motivation to combine Doppenschmitt in view of Knodel.

34. Doppenschmitt discloses a band, yet fails to specifically disclose a closure means attached to the first and second end of the band for releasably connecting the first end to the second end. However, bands having a closure means attached to the ends thereof for releasably connecting the ends are well known in the art. Knodel discloses a band including a closure means 12 attached to the first and second end thereof for releasably connecting the first end to the second end. The closure means facilitates wearing and removing the band as required. Therefore, the motivation to combine Doppenschmitt in view of Knodel is to enhance the securement of the band to the person, i.e. improve the securement of the band to the person by providing a simpler means of wearing and removing the band via the closure means.
35. The applicant argues Doppenschmitt teaches away from the band section being made of an elastic material (that is, material allows the band section to be elongated by stretching). The examiner disagrees as Doppenschmitt discloses the band section 3 as a resilient, i.e. elastic, spring steel (page 2, lines 16-21). In any event, the band section being elongated by stretching is not a claimed feature of the invention.
36. The applicant argues Knodel teaches away from the applicant's friendship necklace embodiment because Knodel's band must be worn snugly on a person's wrist. However, the Knodel reference is not required to specifically disclose a friendship necklace as the applicant is reminded the Knodel reference is being applied as a teaching reference which teaches a general band structure having a closure means on the ends thereof.

*Conclusion*

37. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

38. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fishel and Romano disclose similar "friendship bands".

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is 703 305 3978. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703 306 4115. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9326 for regular communications and 703 872 9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

William L. Miller  
Examiner  
Art Unit 3677

A handwritten signature in black ink, appearing to be 'WLM', with a long horizontal flourish extending to the right.

wlm  
July 25, 2002